

Appl. No. 09/776,309
Amdt. dated September 13, 2004
Reply to Office action of July 6, 2004

REMARKS/ARGUMENTS

Applicant respectfully requests reconsideration and allowance of the pending claims. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

Claims 1-16 remain in prosecution. Claims 9 and 16 have been amended to correct a few minor issues. Claims 1-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Isensee et al. (U.S. Pat. No. 5,815,153) and further in view of Arzoumanian (U.S. Pat. No. 5,963, 637).

The cited Isensee reference teaches a desktop computer (Item 1, FIG. 1) that has a graphical user interface (GUI) that presents a user Interactable object (e.g., telephone object 200, Fig. 4) to a user. The desktop computer is presumably coupled to a network such as the public switched telephone network using communications adapter 34. The computer user interacts with the telephone object ("icon") 200 in order to place a telephone call. For example, by using mouse 26 to select the telephone handset 202 found in the telephone icon 200 and then selecting one of the speed dial buttons 206, or activating the telephone keys 218 found in the telephone object 200 (see Col. 8, lines 25-40). Once a call has been made, the computer user uses the computer's microphone and speaker to conduct a normal telephone conversation (see Col. 4, lines 20-25). Isensee's interactable telephone icon 200 in effect takes the place of a "real" telephone.

The cited Arzoumanian reference teaches a telephone calling card dialer that in the preferred embodiment is a watch that includes a number and tone generating device (see FIG. 1 for block diagram, and FIG. 4 for a drawing showing the watch 10 being presented to a telephone handset 54). The watch can produce DTMF tones that can be used for dialing a telephone number when presented to a telephone handset.

It was mentioned in the Office action as the motivation for combining the Isensee and Arzoumanian references that it would have been obvious to implement an acoustic dialing method in Isensee's system for the purpose of

Appl. No. 09/776,309
Amdt. dated September 13, 2004
Reply to Office action of July 6, 2004

allowing the device (Applicant assumes that by "device" it is meant Isensee's desktop computer system shown in FIG. 1) to reduce the complexity of dialing a public phone. Applicant fails to find such motivation in either reference taken individually or in combination and as such traverses the rejection in view of the cited references. Without such motivation, the combination of references would simply amount to improper hindsight reconstruction.

In Isensee's system, a computer user, as an illustrative example, simply has to press one of the speed dial buttons 206 in the telephone icon 200 found in the computer's GUI to set up a call and then use the computer's speaker and microphone to conduct the telephone conversation. The cited Isensee reference is teaching one of ordinary skill in the art to replace a telephone with an interactive telephone object or icon found in a computer that is coupled to a network. And as such is teaching away from combining the Arzoumanin's watch dialer which requires an actual telephone handset to place a call.

Assuming arguendo that Arzoumanin's watch dialer could somehow be incorporated into Isensee's computer system, attempting to incorporate the Arzoumanin's watch dialer would do away with many if not all of the benefits provided by Isensee's virtual telephone (telephone icon 200). What purpose would having a virtual interactive telephone icon having speed dial and other features as taught by Isensee serve if a "real" telephone would also be required. It seems to Applicant that Isensee is trying to do away with having an actual telephone device by providing a computer user with an interactive telephone icon that mimics the functionality of a real telephone, as such there seems to be no reason why one of ordinary skill in the art would combine the cited references. Applicant fails to see how the computer system discussed in the Isensee reference (see Fig. 1) could be turned into a computer system that could be presented to the handset of a public telephone, much less find any motivation to add an acoustic dialing feature such as that found in the small sized watch dialer disclosed by Arzoumanian.

Since the references taken individually or in combination fail to provide one of ordinary skill in the art any motivation to combine the references, claims 1-16

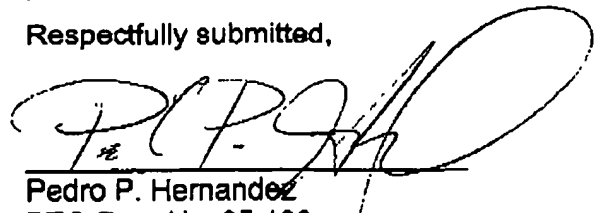
**Appl. No. 09/776,309
Amdt. dated September 13, 2004
Reply to Office action of July 8, 2004**

are believed to be in condition for allowance. Simply taking one aspect of one reference and combining it with another reference without any motivation to combine the references surmounts to improper reconstruction. Given that the two cited references teach away from each other in what they are trying to accomplish, one of ordinary skill in the art would not have found any motivation to combine the references to yield what is claimed by the Applicant.

In the course of the foregoing discussions, Applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



Pedro P. Hernandez
PTO Reg. No. 35,190
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANT

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400